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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,463	06/15/2001	Rajendra Kumar	1386-D-CONT(3)-CIP-CONT	3125

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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT PAPER NUMBER

2635

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,463

Applicant(s)

KUMAR, RAJENDRA

Examiner

Brian A Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 20-26 is/are allowed.
- 6) ☒ Claim(s) 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

EXAMINER'S RESPONSE**Status of Application**

In response to the applicant's amendment received on 11/1/04. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 5-19 are unpatentable for the reasons set forth in this office action:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan (5459702), Rindfuss (4841387) and Mital (5664228).

Greenspan shows a personal organizer and messaging device (figure 2) that is handheld and can be substantially carried in a shirt pocket as claimed. The device includes an audio input means 56 for receiving and recording an audio message as claimed. The device includes a solid state RAM as the memory means for storing the audio message (see col. 13 lines 42+). The device includes an audio output means to selectively play back the stored audio

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message(s). The device includes a handheld housing for carrying the above-mentioned means. The device also selectively communicates with a base station.

In an analogous art, Rindfuss teaches the ability of a playback device to playback stored data (audio data) in a non-sequential manner. Thereby providing improved playback with more flexibility to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a playback mechanism as suggested by Rindfuss in order to provide improved access to stored messages in the Greenspan system.

In an analogous art, Mital shows a handheld (shirt pocket sized) device 104 that can be used to store data. The device can be placed in selective engagement with a portable base station 100. The portable base station has a display on a first side and a cradle and keyboard on the second side where the two sides mate together in an open and closed relationship about a hinge. This provides a convenient portable base station that can update synchronize with a handheld device to provide ease in using the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the portable base station and interface of Mital in the above system in order to provide ease in using the combined system.

2. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (5008854), Yokozawa (4534012), Greenspan (5459702) and Mital (5664228).

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Maeda shows a handheld device with a touch panel 12 that is written on by a stylus 39. The device includes a solid state RAM 53 for storing data, a microprocessor 31 for recalling the stored data and a display 13 for displaying the recalled data.

In an analogous art, Yokozawa shows a handheld data device 31 that can selectively interface with a base station 32 to synchronize the data stored in both the handheld device and the base station. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have interfaced the handheld device of Maeda to a base station to provide increased processing power for the data stored in the handheld device.

Greenspan shows a personal organizer and messaging device (figure 2) that is handheld and can be substantially carried in a shirt pocket as claimed. The device includes an audio input means 56 for receiving and recording an audio message as claimed. The device includes a solid state RAM as the memory means for storing the audio message (see col. 13 lines 42+). The device includes an audio output means to selectively play back the stored audio message(s). The device includes a handheld housing for carrying the above-mentioned means. The device also selectively communicates with a base station.

In an analogous art, Mital shows a handheld (shirt pocket sized) device 104 that can be used to store data. The device can be placed in selective engagement with a portable base station 100. The portable base station has a display on a first side and a cradle and keyboard on the second side where the

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two sides mate together in an open and closed relationship about a hinge. This provides a convenient portable base station that can update synchronize with a handheld device to provide ease in using the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the portable base station and interface of Mital in the above system in order to provide ease in using the combined system.

3. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (5008854), Yokozawa (4534012), Greenspan (5459702) and Mital (5664228) as applied to claim 13 above, and further in view of Vanden Heuvel (5281962).

In an analogous art, Vanden Heuvel shows a handheld shirt pocket sized data storage terminal 110 that interfaces with a portable base station 410. The handheld device includes a wireless communication circuit to receive messages over the wireless circuit and store the messages for later recall. The handheld device can interface to the base station in order to transfer those received messages to the base station so the base station can later recall those messages. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a wireless communication circuit in the handheld device in order to provide the ability to wirelessly receive messages to the handheld device in an efficient and up to date manner.

Allowable Subject Matter

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4. Claims 1-4,20-26 are allowed.

Response to Arguments

Applicant's arguments filed 11/1/04 have been fully considered but they are not persuasive.

The applicant argues that the present application has priority to 1991 and that such priority predates Greenspan, thus eliminating Greenspan as prior art. The present application does have priority for some subject matter back to 1991, but as this application is a continuation in part such priority is not for all subject matter. It remains the examiner's position that the priority granted for the rejected claims does not go back to 1991. The applicant has not provided factual evidence supporting their allegation, such as col. and line numbers for support for the limitations in claim 5. If the applicant can provide column and line numbers for the limitations in the pending claims, to factually prove support, the desired priority date will be given for the rejected claims. Furthermore, the applicant then ignores the filing date of Greenspan when attempting to argue that Greenspan is not prior art. The filing date of Greenspan (7/1/88) predates even the applicants desired (argued) priority date. Therefore, even if the examiner agreed with the applicant's arguments regarding their priority date, such a priority date would not overcome the priority date of Greenspan.

The applicant argues that since Rindfuss is such a large size that the combination of references would necessarily be the same large size and would not fit in a shirt pocket. The applicant argues that the use of handwritten

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notations is inherently large and therefore cannot fit the shirt pocket size limitation as claimed, yet the applicant argues that their touchscreen is small. This is clearly contradictory, either the applicant's inputs are also inherently too large for their application or the applicant is being extremely liberal in their assessment of the Rindfuss disclosure. The examiner takes official notice that it is possible to take handwritten notes in a small area. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The teachings of Rindfuss can easily be applied to a smaller device such as that of Greenspan to suggest the ability to playback previously stored data. More importantly, the rejection does not put forth the combination of the writing teachings of Rindfuss with Greenspan, as the applicant alleges and argues.

The applicant argues that since Greenspan is not identical to the claimed invention, it teaches away. First it is noted that following the applicant's reasoning there would never be a need for 35 USC 103, since any need to apply a secondary reference would preclude the use of a secondary reference because the primary reference (that is not identical) would "teach away." Furthermore, it is well held that the prior art's mere disclosure of more than one alternative does not constitute a teaching away from the claimed invention because such

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disclosure does not criticize, discredit or otherwise discourage the solution set forth in the combination rejection for the claims in the pending application.

Regarding claims 9 and 13, the applicant argues that the references do not teach the newly added limitation. A new grounds of rejection has been added (see above) to address this newly added limitation.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

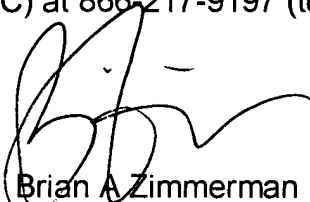
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A. Zimmerman
Primary Examiner
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BAZ